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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/706,678 | 11/06/2000 | Webster Hughes | 4530-1 | 8283 |

27538 7590 08/30/2006

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3693

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/706,678 | Applicant(s) HUGHES, WEBSTER | |
| | Examiner JAGDISH PATEL | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-25, 29-33 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-25, 29-33 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 6/13/06.

Response to Amendment

2. Claims 18,20-25, 29-32 and 46-48 have been amended. Claims 18-25, 29-33 and 46-48 are under examination.

Response to Arguments

3. Applicant's arguments with respect to rejection of claims 18-25, 29-33 and 46-48 over reference and rejection of the claims under 35 USC 112 (second) have been considered in view of the amendment, prior telephone interview with the applicants and their consul and further in view of the remarks presented in the amendment dated 6/13/06. Accordingly, said rejections have been withdrawn.
4. The amended claim(s) have been reviewed under the Interim Guidelines for Subject Matter Eligibility under 35 USC 101 (see link provided below for details). A detailed analysis of the pending claims is presented in the following section.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 18-22, 29-33 and 46-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In accordance with the revised Interim Guidelines for Subject Matter Eligibility (refer to web link, http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html) for details), a claimed invention must satisfy the requirement that it be directed to a "practical application" which is to mean "the claimed invention physically transforms an article or physical object to a different state or thing, or ... the claimed invention otherwise produces a useful, concrete, and tangible result".

To determine whether the claimed invention satisfies the "practical application" requirement, the claimed invention must produce a useful, concrete and tangible result. The focus is on the result of the claim as a whole, not the individual steps or structure used to produce the result.

A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable

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exception or it is merely likely that it would occur, it does not “flow inherently therefrom” and the claim would need to be amended to specifically recite the result.

7. Claim 18 recites a method of processing a commercial transaction wherein a serial chain of transactions is identified based upon a plurality of orders, which include a bid or offer received from a plurality of parties. The claimed invention, however, fails to produce a tangible result because there is no recitation of actual execution of the serial chain of transactions or any part thereof. The claimed invention, therefore, fails to produce a tangible result, which would be the case if it recited actual recitation of the execution of, or part of, the serial chain of transactions.

This deficiency and therefore 101 rejections can be overcome by amending the claim so that a step of the execution of the serial chain is further added to the presently recited claim(s).

This deficiency is also inherited into dependent claims 19-22, 29-33 and 46-48 as none of these claims produce a tangible result.

(Examiner’s Note: The execution of a transaction produces a tangible result because an item or a product changes hands among the concerned parties. Merely identifying a (serial) chain of transactions, on the other hand, does not cause this result. See MPEP § 2106 (8th ed., Rev. 1, February 2003) and/or State Street, 149 F.3d at 1374, 47 USPQ2d at 1601.)

Objection to Claims, Allowable Subject Matter

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Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

8/21/06